IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent application of	)	
	)	
NASH et al.	)	Group: 1657
	)	
Serial No.: 10/506,576	)	Examiner: T. F. Gough
	)	
Filed: September 3, 2004	)	Atty. Dkt. No.: 129597.0102
	)	
For: METHOD FOR MONITORING THE QUALITY OF A HERBAL MEDICINE	)	

REPSONSE TO OFFICE ACTION

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Response is filed in reply to the Office Action mailed September 2, 2009. A Petition for a one-month extension of time and fee therefor are filed herewith.

The Examiner sets forth a species restriction requirement on page 2 of the Office Action, where the Examiner alleges that a species of phytochemicals of claim 1 must be elected because the species do not relate to a single general inventive concept.

Applicants respectfully elect pyrrolodine, with traverse. Specifically, Applicants traverse on the ground that the Examiner has failed to show lack of unity of invention. The present application was filed under 35 U.S.C. § 371, which means that PCT rule 13 (unity of invention) properly applies. *See* MPEP 1893.03(d). The Examiner feigns familiarity with Rule 13 by citing it on page 3 of the Office Action, but her reasoning fails to comply with that rule. In the Office Action, the Examiner alleges that

> the species lack the same or corresponding special technical features for the following reasons: There are hundreds of different piperidine alkaloids and multiple pyrrolodine alkaloids. The species of claim 1 are distinct species derived from different components.

Office Action, page 3. "Distinct species" is not a test for unity of invention. "Distinct species" is a test under U.S. practice, specifically 37 C.F.R. § 1.146. Unity of invention is specified in 37 C.F.R. §1.475.

> When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

MPEP 1893.03(d) (emphasis added). Additionally,

> [t]he expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Id. Here, the Examiner fails to explain 1) what the Examiner considers the common technical feature; and 2) how that common technical feature does not define a contribution over the prior art (i.e. not a "special technical feature"). The Examiner merely alleges distinct species based on USPTO species restriction practice. This is not a proper analysis under PCT Rule 13.

Notwithstanding the Examiner's failure to follow the unity of invention standards, the Examiner has also failed to set forth a proper species restriction in accordance with USPTO practice and the Code of Federal Regulations. According to MPEP 806.04,

> Where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct.

(emphasis added). Further, according to 37 C.F.R. § 1.146,

> In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable.

(emphasis added). Thus, USPTO practice and the Federal Regulations require a generic claim for a species restriction to be properly applied. In this case, the present application contains no generic claim. The only independent, claim 1, recites all species. Thus, the application does not contains "a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby." Accordingly, the Examiner's improper species restriction fails to meet the requirements of MPEP 806.04 and 37 C.F.R. § 1.146.

Therefore, for the reasons noted, Applicants respectfully submit that the species restriction requirement is improper and should be withdrawn.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (129597.0102). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, Applicants hereby petition under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,

Date: November 2, 2009 By: /Charles R. Wolfe, Jr./
Charles R. Wolfe, Jr.
Registration No. 28,680

BLANK ROME LLP
Watergate
600 New Hampshire Avenue, NW
Washington, DC 20037
Telephone: 202-772-5800
Facsimile: 202-572-1400